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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,266	08/21/2003	Patrick E. Godici	37,335	7346

7590 05/23/2007
BP America Inc.
Docket Clerk, BP Legal
M.C. 5East
4101 Winfield Road
Warrenville, IL 60555

EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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05/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/645,266	GODICI ET AL.	
	Examiner	Art Unit	
	James Goloboy	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/12/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-10,13-16,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 6,11,17 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Please note the new examiner of record.

Claim Rejections - 35 USC § 103

2. Claims 1, 3-5, 8-10, 13-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Pat. No. 5,856,280) in view of WO 02/053687 and the evidence disclosed in Meskers (U.S. Pat. No 6,348,440).

The rationale for this rejection is adequately set forth in paragraph 2 of the office action mailed 12/14/06.

Allowable Subject Matter

3. Claims 6, 11, 17, and 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examples in Table 3 on page 11 of the specification show that there is an unexpected synergistic effect between DITMPA and tolutriazole when the additives are used in certain concentrations, compared to compositions comprising other prior art copper passivators, or compared to compositions comprising no DITMPA, which is not taught in the prior art as having copper passivating properties.

Response to Arguments

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Applicant argues that it would not have been obvious to replace the sulfur-containing additive of Kim with the DITMPA additive of Meskers. However, that is not what is set forth in the rejection. Rather, the DITMPA of Meskers is added in addition to the sulfur-containing additive of Kim, in order to provide the benefits taught by Meskers. It is noted that Kim, in column 4 lines 53-56, teaches that additional additives, such as the DITMPA of Meskers, can be added to the composition.

Applicant also argues that the DITMPA and tolutriazole display an unexpected synergistic effect in reducing copper loss. The examiner agrees with this argument as it relates to claims 6, 11, 17, and 20, as discussed in paragraph 3 above. However, the results shown in Table 3 are not commensurate with the scope of the remaining claims, which recite broader concentration ranges of tolutriazole and DITMPA. It is noted that comparisons between Example 2 and Example 3, or Example 8 and Example 9 (at 425° F) in Table 3 actually show an increase in copper weight loss when the concentration of tolutriazole or DITMPA is increased. Therefore, there is no indication that the combination of tolutriazole and DITMPA continues to show unexpected results within the broader ranges of claims 1, 3-5, 8-10, 13-16, and 18-19.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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